

**REMARKS**

Applicants have amended claim 2 to recite a semiconductor layer between the second reflection film and the current constriction layer and having a carrier density that is set so that the current diffused to an outside of a current flow pass formed in the current constriction layer is 25% or less of the total current in the current flow pass. Support for this amendment may be found in paragraphs [0011], [0041]-[0045] and [0048] of the specification. Applicants have also amended claims 5-10 to conform them to this amendment and have added claim 11 to round out the coverage. With the entry of these amendments, claims 1-11 are pending in this application.

Claims 2, 4, 6, 8 and 10 were rejected under 35 USC 102(b) as being anticipated by Kurahashi, JP 2001-068727. This rejection is respectfully traversed.

Kurahashi does not anticipate the claims as amended because it does not teach or suggest the provision of a semiconductor layer between the second multilayered reflection film and the current constriction layer that has a carrier density of any given amount, let alone a semiconductor layer having a carrier density which is set to control to a specified degree the percentage of the carrier diffused the outside of a current flow formed in the current constriction layer applied to the current flow layer, as claimed. To recognize or teach this feature of the invention means that it can neither anticipate nor render obvious the subject matter of claims 2, 4, 6, 8 and 10. Applicants also note that Kurahashi does not disclose the semiconductor layer claimed in claim 11. Accordingly, the anticipation rejection on Kurahashi should be withdrawn.

Claims 1, 3, 5, 7 and 9 were rejected under 35 USC 103(a) as being unpatentable over Kurahashi. This rejection is respectfully traversed.

The Examiner admits that Kurahashi does not expressly teach the value of the semiconductor layer obtained by dividing resistivity by thickness. The Examiner took the position that it would have been "an obvious matter of routine experimentation to find the optimal resistive ranges." Citing the ancient case of *In re Aller*, the Examiner found that it would have been obvious

to one of ordinary skill in the art “to select the resistivity of the semiconductor layer, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.”

The difficulty with the Examiner’s position is that it assumes that persons of ordinary skill in the art would have recognized from Kurahashi by itself that selecting the claimed relationship between resistivity and thickness as set forth in claim 1 would have been considered by persons of ordinary skill in the art reading Kurahashi (and without knowledge of the claimed invention) to be of any significance whatever. Kurahashi is devoid of any recognition of a correlation between the response characteristics of the semiconductor light emitting device and the resistivity of the semiconductor layer disposed between the second multilayered reflection film and the current constriction layer as a function of the thickness of the semiconductor layer. Because the prior art contains no disclosure whatever that the claimed value of the semiconductor layer is a result-effective variable or otherwise has an effect of any kind in the environment of the claimed invention, there is no evidence that persons of ordinary skill in the art would even have been motivated to carry out the alleged “routine experimentation” to arrive at the claimed invention that the Examiner says would have rendered the invention obvious. As the Court of Appeals for the Federal Circuit pointed out in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1439 (Fed. Cir. 2002):

When patentability turns on the question of obviousness, an analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. . . . This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.

In this case, the Examiner is substituting subjective belief of what constitutes “routine experimentation” for evidence of record that persons of ordinary skill in the art would have thought

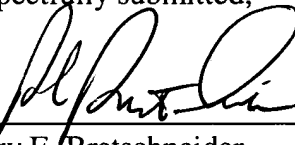
to carry out "routine experimentation" in the first place and what that experimentation would have entailed. Accordingly, the rejection of claims 1, 3, 5, 7 and 9 under 35 USC 103(a) on Kurahashi should be withdrawn.

Early action allowing claims 1-11 is solicited.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 204552028600.

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Respectfully submitted,

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